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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,600	07/12/2001	Greig C. Scott	05490H028010	2591
22434	7590	12/15/2006	EXAMINER	
BEYER WEAVER & THOMAS, LLP			ROZANSKI, MICHAEL T	
P.O. BOX 70250			ART UNIT	
OAKLAND, CA 94612-0250			PAPER NUMBER	
			3768	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/904,600

Applicant(s)

SCOTT ET AL.

Examiner

Michael Rozanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/26/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-13 and 15-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by McGee et al (US Patent No. 5,722,403).

Claims 1-5: McGee et al. disclose a system and method for imaging interior tissue regions utilizing an electrode assembly. The system includes a probe adaptable for detecting MRI signals emitted from a conducting medium, which may comprise tissue or fluid (col. 6, line 56 – col. 7, line 4; col. 19, line 65 – col. 20, line 18; col. 22, lines 31-38). One or more electrodes may be positionable on or within the object in proximity to the region of interest, distal ends of the electrodes being spaced apart and disconnected, the and the electrodes being functional with the conducting medium as a coil (col. 24, line 56 – col. 25-, line 65). Furthermore, the system includes feed wires

coupling proximal ends of the electrodes to a signal detector (col. 15, lines 52-65; col. 22, lines 10-18).

Claims 6, 7, 9, and 10: McGee et al. disclose the probe wherein electrodes are carried by a catheter and the electrodes are rings around the circumference of the catheter (col. 12, lines 17-30).

Claims 8 and 11: McGee et al. disclose electrodes that are capable of being extendable from and retractable within the catheter (col. 5, lines 17-32; col. 10, lines 1-42).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGee et al. in view of Crowley et al (US Patent No. 6,004,269).

Claim 12: McGee et al. disclose all claimed features in claim 2, but fail to disclose the probe wherein the electrodes comprise needles. However, attention is drawn to Crowley et al., which teach of an imaging system with electrodes mounted on the distal portion of a catheter. The electrodes comprise needles (col. 28, line 37 – col.

29, line 28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in order to facilitate MRI signal detection.

6. Claims 13, and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGee et al. in view of Glowinski et al (US Patent No. 5,868,674).

Claim 13: McGee et al. disclose a method of imaging a region of interest including a conducting medium (col. 19, line 65 – col. 20; col. 22, lines 31-38). This includes the step of applying RF excitation pulses to the region and detecting MRI signals with one or more spaced and disconnected electrodes. Further, the electrodes are functional with the conducting medium as a coil (col. 12, lines 7-30; col. 24, line 6 – col. 25, line 65). McGee et al., however, do not disclose the step of placing the object in a static magnetic field. Glowinski et al. teaches of a similar device that includes an MR device 1, a catheter 15, RF transmitter coils. The system is capable placing an object in a static magnetic field, as described by the applicant (col. 4, lines 21-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in order to facilitate MRI function and signal detection.

Claims 16-18: McGee et al. disclose the probe wherein electrodes are carried by a catheter and the electrodes are rings around the circumference of the catheter (col. 12, lines 17-30). In addition, McGee et al. disclose electrodes that are capable of being extendable from and retractable within the catheter (col. 5, lines 17-32; col. 10, lines 1-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teachings of Glowinski et al., as shown for claim 13, to that of McGee et al.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGee et al. in view of Glowinski et al., and in further view of Crowley et al.

Claim 15: McGee et al. and Glowinski et al. do not teach that the electrodes comprise needles. However, attention is drawn to Crowley et al., which teach of an imaging system with electrodes mounted on the distal portion of a catheter. The electrodes comprise needles (col. 28, line 37 – col. 29, line 28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made in order to facilitate MRI signal detection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of art is cited to show an MR imaging system for vascular procedures.

US Patent No. 5,792,005 to McKinnon disclose an MRI apparatus 1, magnet system 2, coil structure 5, and RF energy source 6.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Rozanski whose telephone number is 571-272-1648. The examiner can normally be reached on Monday - Friday, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader can be reached on 571-272-4740. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



MR



ELENI MANTIS MERCADER
SUPERVISORY PATENT EXAMINER